



3724

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, with sufficient postage, in an envelope addressed to: Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450, on the below date:

Date: March 8, 2005 Name: Thomas J. Wrona, Ph.D., Reg. No. 44,410 Signature:

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Appln. of: Michael A. Schmidt et al.

Appln. No.: 10/027,467

Filed: December 20, 2001

For: AUTOMATIC SHEET THREADING AND
CUTTING DEVICE AND METHOD

Attorney Docket No: 659/793

Examiner: Ghassem, Alie

Art Unit: 3724

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL

Sir:

Attached is/are:

- ☒ Transmittal Letter (in duplicate) and Response to Restriction/Election Requirement.
☒ Return Receipt Postcard

Fee calculation:

- ☒ No additional fee is required.
☐ Small Entity.
☐ An extension fee in an amount of \$_____ for a _____-month extension of time under 37 C.F.R. § 1.136(a).
☐ A petition or processing fee in an amount of \$_____ under 37 C.F.R. § 1.17(____).
☐ An additional filing fee has been calculated as shown below:

					Small Entity			Not a Small Entity	
	Claims Remaining After Amendment		Highest No. Previously Paid For	Present Extra	Rate	Add'l Fee	or	Rate	Add'l Fee
Total		Minus			x \$25=			x \$50=	
Indep.		Minus			x 100=			x \$200=	
First Presentation of Multiple Dep. Claim					+\$180=			+\$360=	
					Total	\$		Total	\$

Fee payment:

- ☐ A check in the amount of \$_____ is enclosed.
☐ Please charge Deposit Account No. 23-1925 in the amount of \$_____. A copy of this Transmittal is enclosed for this purpose.
☐ Payment by credit card in the amount of \$_____ (Form PTO-2038 is attached).
☒ The Director is hereby authorized to charge payment of any additional filing fees required under 37 CFR § 1.16 and any patent application processing fees under 37 CFR § 1.17 associated with this paper (including any extension fee required to ensure that this paper is timely filed), or to credit any overpayment, to Deposit Account No. 23-1925.

Respectfully submitted,

Thomas J. Wrona, Ph.D. (Reg. No. 44,410)

March 8, 2005
Date



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with the United States Postal Service, with sufficient
postage, as first class mail in an envelope addressed to:

Commissioner for Patents
Alexandria, VA 22313
on March 8, 2005

Date of Deposit
Thomas J. Wrona, Ph.D., Reg. No. 44,410

Name of applicant, assignee or
Registered Representative

Signature

3/8/05
Date of Signature

Our Case No. 659/793

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Michael A. Schmidt et al.

Serial No. 10/027,467

Filing Date: December 20, 2001

For AUTOMATIC SHEET THREADING
AND CUTTING DEVICE AND
METHOD

Examiner Ghassem, Alie

Group Art Unit No. 3724

RESPONSE TO RESTRICTION/ELECTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This communication is in response to the Office Action mailed on February 8, 2005.
The Office Action asserts that the claims are directed to three patentably distinct species
of the claimed invention:

Species I. Apparatus in claims 14-25 having the nip rollers as the only cutting device to brake or cut the sheet material;

Species II. Apparatus in claims 14-25 having the transfer blade as the cutting device and the nip rollers as rollers for creating tension when the sheet is contacted with the transfer blade; and

Species III. Apparatus in claims 14-25 having the transfer blade as the only cutting device for cutting the sheet of material.

The Action requires the election of one of the above species and further asserts that no claim is generic. Applicant respectfully traverses.

Regarding the assertion that none of the pending claims are generic, Applicant respectfully disagrees. MPEP § 806.04(d) provides “a generic claim should include no material element additional to those recited in the species claims, and must comprehend within its confines the organization covered in each of the species.” Claim 14 is directed to an apparatus for cutting and threading a sheet material. Claims 15-22 depend from claim 14. Claim 14 does not contain a material element additional to those recited in claims 15-22. Moreover, claim 14 includes within its scope all of the Species set out by the Examiner. Thus, claim 14 is generic to the species set forth in claims 15-22. Similarly, claim 23 is generic to claims 24-25. Applicant respectfully requests reconsideration of whether any of the claims are generic.

By asserting that the present claims lack a generic claim and that Species I-III are patentably distinct, the Action is essentially a restriction requirement between the three Species/Groups. Applicant respectfully traverses this restriction on the grounds that concurrent examination on the merits of the invention of Species I-III would not place a serious burden on the Examiner.

According to MPEP § 803, two criteria are necessary to justify a requirement for restriction between patentably distinct invention:

- (1) The inventions must be independent or distinct as claimed; and
- (2) There must be a serious burden on the Examiner if restriction is not required.

"[A] serious burden on the examiner may be prima facie shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined by MPEP § 808.02."

Applicant submits that the Examiner has not established that it would be unduly burdensome to examine the three Species. Indeed, the Action lacks any explanation as to whether the species are within a separate classification, separate status in the art, or different field of search. The Examiner asserts that the restriction is due to statements made by Applicant in its Response of October 27, 2004 that the sheet of material can be cut optionally either with the transfer blade, the nip rollers, or the combination of the transfer blade and nip rollers. The present claims, however, are original claims directed to embodiments clearly explained in the specification (see, e.g., page 11, lines 26). These claims already have been the subject matter of two office actions on the merits. It is difficult to reconcile how Applicant's pointing out that which was clearly described in the claims and specification has created a burden on the Examiner. As explained in MPEP § 803, "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions."

Accordingly, Applicant requests that the requirement to elect from Species I-III be withdrawn, and that they continue to be examined concurrently on the merits for their full scope. Nonetheless, if required to elect a Species for examination, Applicant provisionally elects Species II.

If the present submission presents any issues that can be resolved by a telephone interview, the Examiner is invited to contact Applicants' undersigned representative at the number below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'T. Wrona', is written over a horizontal line.

Thomas J. Wrona, Ph.D.
Registration No. 44,410
Attorney for Applicant

BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO, ILLINOIS 60610
(312) 321-4200